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| 58139 | 7590 | 05/20/2009 | | |
| IBM CORP. (WSM) c/o WINSTEAD SECHREST & MINICK P.C. P.O. BOX 50784 DALLAS, TX 75201 | | | EXAMINER CAMPBELL, JOSHUA D | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID K. McKNIGHT and EDUARDUS A.T. MERKS

Application 09/489,793

Mailed: May 20, 2009

Before CAROLYN L. JOHNSON, *Supervisory Paralegal Specialist*.

CAROLYN L. JOHNSON, *Supervisory Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences (hereinafter the “Board”) on June 16, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below:

On February 27, 2007, the Board mailed an Order Remanding to the Examiner (hereinafter “Remand”) wherein the Board ordered that the Examiner require Appellants to place the claims on appeal in proper form. On May 16, 2007,

the Examiner mailed a Supplemental Examiner's Answer in response to the Remand. On page 2 of the Supplemental Answer, the Examiner introduces a new objection under 37 C.F.R. § 1.75(c) and a new rejection under 35 U.S.C. § 101 (set forth in the Examiner's Answer mailed on June 5, 2006).

According to MPEP § 1207.03:

37 CFR § 41.39(a)(2) permits the entry of a new ground of rejection in an examiner's answer mailed on or after September 13, 2004. . . . In such an instance where a new ground of rejection is necessary, the examiner should either reopen prosecution or set forth the new ground of rejection in the Answer. The examiner must obtain supervisory approval in order to reopen prosecution.

In addition, any new ground of rejection made by an examiner in the Answer must be approved by a Technology Center (TC) Director or designee, and prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the Answer.

AMENDMENT AFTER FINAL

Appellants filed an Amendment after Final on May 23, 2007. There is no Advisory Action (PTO-303) to indicate on the record if the amendment is approved for entry.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- (1) reopen prosecution to address the new ground of rejection, or
- (2) obtain approval from a TC Director or appropriate designee,
- (3) consider the Amendment filed on May 23, 2007 as required and indicate entry or non-entry via an Advisory Action, and
- (4) for such further action as may be appropriate.

If there are any questions pertaining to this order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

CLJ

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